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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/240,895	05/11/94	COMISKEY	S 17234

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IM71/1113

EXAMINER

YAMNITZKY, M

ART UNIT

PAPER NUMBER

1774

3d

DATE MAILED: 11/13/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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Commissioner of Patents and Trademarks

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11/06/98

APPROVED

NOV 06 1998
Theodore Morris
THEODORE MORRIS
DIRECTOR, GROUP 1900

Office Action Summary	Application No. 08/240,895	Applicant(s) Stephen W. COMISKEY et al.
	Examiner M. Yamnitzky	Group Art Unit 1774



Responsive to communication(s) filed on 01/13/98 and 10/22/98

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three (3) month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

Claim(s) 1-9, 11-16, and 20 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

Claim(s) _____ is/are allowed.

Claim(s) 1-9, 11-16, and 20 is/are rejected.

Claim(s) _____ is/are objected to.

Claims _____ are subject to restriction or election requirement.

Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on _____ is/are objected to by the Examiner.

The proposed drawing correction, filed on _____ is approved disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All Some* None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) _____.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1774

1. Applicants' amendment filed 01/13/98 (Paper No. 28), cancelling claims 17-19, has been entered.

Applicants' communication filed 10/22/98, requesting immediate issuance of a notice of allowance, is acknowledged.

2. Claims 1-9, 11-16 and 20 are pending.

This application was filed with claims 1-20. The examiner determined that the application contained claims directed to three patentably distinct species of the claimed invention: species 1 - stencil/eye black; species 2 - decal; species 3- temporary tattoo. In response to a requirement to elect a single disclosed species for prosecution on the merits, applicants elected to prosecute the invention of species 3 (temporary tattoo). Accordingly, claims 1, 2, 6-13 and 16-19, which read on the elected species, were examined on the merits. Claims 3-5, 14, 15 and 20 were withdrawn from consideration as being drawn to non-elected species. See pages 2-3 of Paper No. 5.

Claims 3-5, 14, 15 and 20 remained withdrawn from consideration during appeal of the examiner's final rejection of claims 1, 2, 6-13 and 16-19.

The decision of the Board (Paper No. 21) is an affirmance in part and included a new rejection under 37 CFR 1.196(b). The decision of the Board reversed the examiner's rejections under Section 103 stating "considerable speculation and assumptions are necessary to determine the metes and bounds of what is being claimed" and "a rejection under 35 USC 103 cannot be based upon speculation and assumptions". The Board pointed out that the reversal "should not be

Art Unit: 1774

construed as an indication that the claimed subject matter would not have been obvious in view of the prior art cited against the claims.” See the paragraph bridging pages 16 and 17 of Paper No. 21.

In response to the Board’s new rejection under 37 CFR 1.196(b), applicants submitted an amendment (received 08/12/96, Paper No. 23) which was subsequently entered. With the entry of the amendment, the scope of pending independent claim 1 became different than the scope of any of the previously examined claims. Amended claim 1, with claims 2-9, 11-16 and 20 dependent therefrom, is now considered in view of the decision of the Board.

In consideration of the decision of the Board, especially the Board’s footnote on page 17 of Paper No. 21, and in consideration of the sheet of paper submitted with Paper No. 23 on which panther and wildcat head transfers are applied, claims limited to the elected species (temporary tattoo) contain allowable subject matter. Accordingly, further action is necessary to consider the two nonelected species (stencil/eye black and decal). See MPEP 1214.06 (III).

In considering the two nonelected species, a search of the prior art found prior art relevant to one of the nonelected species (decal). That prior art is applied in this Office action.

3. Claims 1-9, 11-16 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 1774

Proper antecedent basis is lacking for “the non-toxic material having a non-reflective colored and finished exterior” as recited in the last two lines of claim 1, with claims 2-9, 11-16 and 20 directly or ultimately dependent from claim 1. The phrase “non-reflective colored and finished exterior” was deleted by applicants from step (a) of claim 1 in response to the Board’s 37 CFR 1.196(b) rejection. In approving entry of the amendment filed 08/12/96, the examiner apparently overlooked the inconsistency created by applicants’ changes. The phrase “having a non-reflective colored and finished exterior” should be deleted from the last two lines of claim 1.

Claim 4 is confusing in reciting “wherein *step (a)* is further practiced by repeating *the steps of claim 3*” because “the steps of claim 3” include step (a) and step (b). The examiner suggests changing “wherein step (a)” to --which-- in line 1 of claim 4.

There is no antecedent basis for “the non-reflective material” as recited in line 3 of claims 5 and 15. The examiner suggests changing “non-reflective” to --non-toxic--.

Claim 20 is confusing in recited “produced according to the method of claim 3” because the method of claim 3 includes the step of wiping off the eye black, washing of the eye black with soap and water, or both wiping it off and washing it off. Since the final result provided by all of the steps of the method of claim 3 is not an eye black clearly demarcated geometric and predefined shape, claim 20 is not understood. The examiner notes that if all the steps of claim 3 are followed, any cleanly washed face would meet the limitations of claim 20.

4. Miscellaneous:

Art Unit: 1774

In line 2 of claim 3, "eye" should read --eyes--.

In line 3 of claim 8, the comma should be deleted.

In line 5 of claim 9, "overseas" should read --oversees--.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 2 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by either of Micchia et al. (4,719,909) or Seber (4,745,916).

Both of these patents disclose the adhesive application of black, light absorbing materials to a person's cheeks in order to reduce reflection of incident light into the person's eyes.

See the entirety of both patents. In particular, see Fig. 1, col. 2, lines 14-55 and col. 3, lines 8-37 in the patent to Micchia et al., and see Fig. 3, col. 1, lines 6-51, col. 3, lines 27-50 and Example II (col. 4, line 30 to col. 5, line 7) in the patent to Seber.

The black, light absorbing materials of these two patents inherently meet the wavelength limitation set forth in present claim 1.

The devices of these two patents have a predefined clearly demarcated geometric shape which inherently provides a non-verbal communication to others such as "I'm an athlete", "I'm participating in an athletic event".

Art Unit: 1774

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 8, 9 11-13 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over either one of Micchia et al. ('909) or Seber ('916) as applied to claims 1, 2 and 5 above.

The disclosure of these two patents is as set forth above. Neither of these two patents disclose a representation of a sports team name, mascot or logo as required by present claim 11, a sports apparel or equipment manufacturer's or distributor's logo as required by present claim 8, a sports apparel or equipment manufacturer's or distributor's logo and/or letters identifying the manufacturer or distributor as required by present claims 9, 12, 13 and 15, or the application of logos having a directional bias as required by present claim 13.

It would have been within the general skill of a worker in the art at the time of the invention to provide the prior arts' light absorbing devices in different shapes/designs. It would have been within the general skill of a worker in the art at the time of the invention, as a matter of routine experimentation, to determine suitable shapes and designs within the confines of the prior arts' requirement for reducing reflected light. Both patents teach die cutting in the manufacture of the light absorbing devices; it would have been within the general skill of a worker in the art to utilize different die shapes, motivated by the desire to provide light absorbing devices of different

Art Unit: 1774

shapes. Seber also teaches that the tapes and patches are "attractive and stylish or fashionable" (c. 1, l. 49-51) and that designs or graphics may be printed on the tapes and patches to make the tapes and patches items of fashion wear in addition to their sun or glare protective function (c. 2, l. 8-13).

9. Claims 3, 4, 6, 7, 14 and 16 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

The prior art of record does not disclose nor suggest a method as set forth in these claims wherein stencil and eye black is used (claims 3, 4 and 14) or wherein a temporary tattoo is used (claims 6, 7 and 16).

10. A rejection of the pending claims as unpatentable over conventional temporary tattoos as exemplified by the Team Dynamics, J.B. Marketing, Inc., and Anderson's brochures supplied with applicants' Information Disclosure filed 05/11/94 is not made. No rejection is made based on this previously applied prior art in view of the changes made to claim 1 in Paper No. 23, amended claim 1 being considered in light of the Board's footnote on page 17 of Paper No. 21 and the sheet of paper submitted with Paper No. 23 on which panther and wildcat head transfers are applied. With respect to applicants' comments in Paper No. 23 regarding the footnote and the color versions of the brochures, the examiner notes that the brochures are shiny. The examiner

Art Unit: 1774

cannot determine from looking at the shiny brochures whether the skin transfers shown in the brochures are actually shiny themselves. However, the shiny surface of the transfers as applied to the paper submitted with Paper No. 23 is clearly observable.

With respect to the Board's reference, in the footnote, to "the tattoos and decals cited by the examiner", the examiner notes that the terms "tattoos" and "decals" as used in the present application designate different structures. The examiner did not cite decals, only temporary tattoos.

11. The references made of record and not relied upon is considered pertinent to applicants' disclosure.

DeMatteo et al. (4,783,350) is of interest in discussing decals for application to a person's face (e.g. see col. 1, lines 24-43).

Davis (4,936,325), Mooney (4,957,124), and Hirzel (5,186,190) are of interest as disclosing methods of applying coloring material(s) to a person's face using a stencil. However, none of these patents suggest the method of present claims 3, 4 and 14 wherein reflected light glare is reduced by using a stencil to apply eye black to a reflective location on a person's cheek.

Mohammed (5,816,269) is of interest as disclosing a method of applying a temporary tattoo using a stencil mechanism. In particular, see col. 4, lines 8-17 and c. 4, l. 51 to c. 5, l. 3. Mohammed does not constitute prior art based on the filing date of the present application.

Art Unit: 1774

12. Any inquiry concerning this communication should be directed to Marie R. Yamnitzky at telephone number (703) 308-4413. The examiner can generally be reached at this number from 6:45 a.m. to 3:15 p.m. Monday-Friday.

Effective 03/09/98, Art Unit 1317 became Art Unit 1774. The current fax numbers for Art Unit 1774 are (703) 305-3599 for official after final faxes and (703) 305-5408 for all other official faxes. (Unofficial faxes for Art Unit 1774 can be sent to (703) 305-5436.)

Mey

11/06/98

MARIE YAMNITZKY
PRIMARY EXAMINER

APPROVED

NOV 06 1998
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